



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/702,215      | 10/30/2000  | John K. Hughes       | SYM-16              | 9461             |

7590

07/31/2003

Peiman Sharifi  
Fish & Neave  
1251 Avenue of the Americas  
New York, NY 10020-1104

EXAMINER

DAVIS, TEMICA M

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 07/31/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/702,215

Applicant(s)  
Hughes et al.

Examiner  
Temica M. Davis

Art Unit  
2681



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 30, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2681

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed October 30, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

Specifically, all of the "Other Documents" cited in the IDS are not presently in the application. Included in a response to this action, it is requested that the applicant re-submit all of the "Other Documents" so they can be reviewed by the examiner. The IDS has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was

Art Unit: 2681

not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 4-12, 14, 15, 17-24, 27, 28, 30-38, 40 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Renko et al (Renko), U.S. Patent No. 6,148,203.

Regarding claims 1, 14 and 27, Renko discloses a universal remote terminal/method/system for use in wireless local area networks in a plurality of countries, each country having particular communications specifications for operating wireless local area networks in that country, the terminal comprising circuitry configured to: scan to find a communications channel carrying a communication for a nearby wireless local area network (col. 3, lines 32-46); send a probe communications message (in the registration sequence) on the communication channel in response to finding the communications channel when scanning; receive a reply communications message (in the registration sequence) comprising country-specific information from a transmitter in a particular country that was sent in reply to the probe communications message (col. 3, lines 51-67); and adapt to that country's communications specifications to suitably operate in wireless local area networks in that country in response to receiving the country-specific information (col. 3, lines 58-67 and col. 6, lines 1-7).

Art Unit: 2681

Regarding claims 2, 15 and 28, Renko discloses the universal remote terminal/method system of claims 1, 14 and 27 wherein the remote terminal is mobile and handheld, and the remote terminal comprises wireless-network-interface resources comprising the circuitry (col. 2, lines 25-34).

Regarding claims 4, 17 and 30, Renko discloses the universal remote terminal/method system of claims 1, 14 and 27 wherein the circuitry that is configured to scan is configured to scan frequencies for a broadcast transmission (col. 3, lines 51-67).

Regarding claims 5, 18 and 31, Renko discloses the universal remote terminal/method system of claims 4, 14 and 30 wherein the circuitry that is configured to scan is configured to scan for the broadcast transmission when the terminal seeks to associate with a new access point (col. 5, lines 58-67).

Regarding claims 6, 19, 20, 32 and 33, Renko discloses the universal remote terminal/method system of claims 1, 14 and 27 in which an access point comprises the transmitter, wherein the circuitry that is configured to scan is configured to scan a plurality of channels to receive a broadcast transmission when seeking to associate with a new access point; the circuitry is configured to receive a broadcast transmission on one of the channels; and the circuitry that is configured to send the probe communications message is configured to send the probe communications message requesting country-specific information on the one channel in response to receiving the broadcast transmission (col. 3, lines 51-67 and col. 5, lines 58-67).

Art Unit: 2681

Regarding claim 7, Renko discloses the universal remote terminal of claim 6 wherein the circuitry is configured to scan channels on which the terminal is operable (col. 2, line 50-col. 3, line 31).

Regarding claim 8, Renko discloses the universal remote terminal of claim 1 wherein the circuitry is configured to include a database of communications specifications for a plurality of countries (col. 3, lines 50-63; figure 1).

Regarding claim 9, Renko discloses the universal remote terminal of claim 1 wherein the circuitry is configured to receive the reply communications message comprising country-specific information on that country's communications specification from the transmitter (col. 5, line 58-col. 6, line 7).

Regarding claim 10, Renko discloses the universal remote terminal of claim 9 wherein the circuitry is configured to receive the reply communications message comprising country-specific information comprising a particular set of frequency channels on which wireless local area networks in that country are to operate (col. 3, lines 51-67 and col. 5, line 58-col. 6, line 7).

Regarding claim 11, Renko discloses the universal remote terminal of claim 9 wherein the circuitry is configured to: be operable on a plurality of channels; receive country-specific information on a particular subset of the plurality of channels on which local area networks in that country are to operate (col. 5, line 58-col. 6, line 7).

Regarding claims 21, 34 and 43, Renko discloses the universal remote terminal/method/system of claims 14, 27 and 40 further comprising a database

Art Unit: 2681

of communications specifications for a plurality of countries at the remote terminal (col. 3, lines 32-67 and col. 4, lines 36-63).

Regarding claims 22 and 35, Renko discloses the method/system of claims 14 and 27 wherein said receiving comprises receiving country-specific information on that country's communications specification from the transmitter (col. 3, lines 58-67).

Regarding claims 23 and 36, Renko discloses the method/system of claims 22 and 35 wherein said receiving comprises receiving country-specific information comprising information on a particular set of frequency channels on which wireless local area networks in that country are to operate (col. 3, line 51-col. 4, line 18).

Regarding claims 24 and 37, Renko discloses the method/system of claims 22 and 35 comprising using a plurality of channels to communicate in different countries; and said receiving comprises receiving country-specific information on a particular subset of the plurality of channels on which wireless local area networks in that country are to operate (col. 3, line 51-col. 4, line 18).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

Art Unit: 2681

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 12, 16, 25, 29, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renko in view of Haartsen, U.S. Patent No. 6,574,266.

Regarding claims 3, 16 and 29, Renko discloses the universal remote terminal/method/system of claims 1, 14 and 27 as described above.

Renko, however, fails to disclose wherein the terminal is a desktop personal computer having wireless-network-interface resources.

In a similar field of endeavor, Haartsen discloses a base station-assisted terminal-to-terminal connection setup. Haartsen further discloses a system that utilizes desktop personal computers having wireless-network-interface resources used in scanning to find channels in order to operate in a WLAN (col. 1, lines 14-44, col. 7, lines 23-34, col. 11, lines 14-41 and col. 12, lines 28-49).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Renko with the teachings of the desktop personal computers having wireless-network-interface resources in Haartsen since such devices are widely known and used in the telecommunications industry.

Regarding claims 12, 25, 37 and 41, Renko discloses the terminal/method/system of claims 1, 14, 35 and 40 as described above. Renko, however, fails to disclose wherein the terminal/method/system operate in conjunction with Spread Spectrum technology.



Art Unit: 2681

Haartsen discloses a base station-assisted terminal-to-terminal connection setup method which uses Spread Spectrum technology.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Renko with the Spread Spectrum technology taught in Haartsen since Spread Spectrum is a well known technique used to increase system capacity.

6. Claims 13, 26, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renko in view of Siddiqui et al (Siddiqui), U.S. Patent No. 6,292,666.

Regarding claims 13, 26, 39 and 42, Renko discloses the terminal/method/system of claims 1, 14, 27 and 40 as described above. Renko, however, fails to disclose wherein the circuitry in the terminal is adapted to receive country specific information on a country's name in a communications message.

In a similar field of endeavor, Siddiqui discloses a system and method for displaying a country name on a mobile station display (col. 3, lines 1-40).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Renko with the teachings of Siddiqui for the purpose of assisting the user in dialing the correct national format in the event that the user has roamed into a new country, thereby saving valuable system resources when routing the call (Siddiqui, col. 2., lines 51-56).

Art Unit: 2681

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 customer service whose telephone number is (703)306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

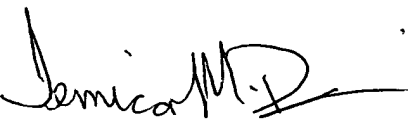
(703) 872-9314 (for any communications intended for entry).

*Hand-delivered responses should be brought to Crystal Park II, 2121*

*Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).*

TMD

July 28, 2003

  
**TEMICA M. DAVIS**  
**PATENT EXAMINER**